

Applicant : Steven K. Coulthard
Serial No. : 10/656,446
Filed : September 5, 2003
Page : 6 of 10

Attorney's Docket No.: 16217-002001

REMARKS

Claims 1-17 are pending. Claims 1-6, 8-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,463,936 ("Hicks") in view of U.S. Patent No. 6,142,769 ("Walker"). Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks as applied to claim 1, and further in view of Hawley's Condensed Chemical Dictionary (pp. 3 and 1097). The applicant respectfully traverses the rejections in view of the amendments and remarks herein, and requests reexamination and reconsideration of the claims.

Claims 1-10

Claim 1 recites an apparatus for extinguishing and containing a cigarette. The apparatus includes the following features:

- a container having an open end, a hollow interior having a substantially constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end forming the hollow interior, wherein the open end is permanently open and is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette;

- a clip including:

- a first portion grasping an exterior of the container; and
 - a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm; and
 - a bottle opener connected to the exterior of the container.

The Examiner asserts that all of the limitations, with the exception of the bottle opener, are disclosed by Hicks. The applicant respectfully disagrees. First, the claim recites a container having an "open end" and has been amended to clarify that the open end is "permanently open". By contrast, Hicks teaches against such a container. Hicks recites a container that includes a cylindrical stopper (see element 38, FIG. 1). Hicks does disclose an embodiment that does not

Applicant : Steven K. Coulthard
Serial No. : 10/656,446
Filed : September 5, 2003
Page : 7 of 10

Attorney's Docket No.: 16217-002001

include a stopper (see FIG. 4), however, this embodiment requires a slot 58 extending from the open end of the container at least partially toward the closed end, and includes a base 60 to hold the container at an angle. Claim 1 requires a continuous wall (e.g., in one embodiment, a cylindrical wall) that extends from the open end to the closed end, the wall forming the hollow interior. The embodiment shown in Hicks a FIG. 4 may include an open end, but does not include such a continuous wall, as Hicks specifically requires the presence of slot 58, therefore teaching against a continuous wall.

Further, claim 1 requires that the hollow interior has a substantially constant interior diameter. Hicks teaches away from a container having a hollow interior with a substantially constant interior diameter. Hicks specifically discloses that interior surface has a diameter of about 0.0350 inches adjacent to the bottom wall. The sidewalls taper radially outwardly from adjacent to the bottom toward the upper end, with a taper of about 1 degree with respect to its axis over the majority of its extent. Accordingly, the interior diameter of the container disclosed in Hicks clearly is not substantially constant: rather there is a taper of 1 degree. Accordingly, not only does Hicks not disclose a container as recited in claim 1, but teaches against a container having a substantially constant interior diameter.

The second limitation of claim 1 requires "a clip including a first portion grasping an exterior of the container, and a first and a second resilient arm, each arm extending from the first portion configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm". Hicks does not disclose such a clip. Hicks does disclose that a wire having a central extent in a generally oval shape can be pivotally secured to an oval collar secured to a central extent of the housing for optionally holding a lighter (Col. 5, lines 13-18). However, this wire does not disclose the clip recited in claim 1. The clip recited clearly includes a first and a second resilient arm, the arms bowed toward one another and configured to grasp a cigarette lighter. Hicks does not disclose a clip that includes two such resilient arms, and therefore fails to satisfy the limitation.

Hicks fails to disclose a bottle opener connected to the exterior of the container, as required by the claim. However, the Examiner relies on a combination of Hicks and Walker to

Applicant : Steven K. Coulthard
Serial No. : 10/656,446
Filed : September 5, 2003
Page : 8 of 10

Attorney's Docket No.: 16217-002001

satisfy this limitation. Walker discloses a multi-purpose tool, which may include a bottle opener and a lighter.

Applicant respectfully submits the Examiner has failed to show a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" [MPEP, §2143]. The Examiner has combined a first reference, Hicks, that discloses a cigarette handling system, with a second reference, Walker, that discloses a multi-use tool.

The applicant respectfully submits there is no motivation to combine Hicks and Walker, either explicitly or implicitly in the references. Walker's tool does not include a container to retain a cigarette. The applicant respectfully submits there is no motivation, either express or implicit in the references, to combine Walker's teaching of a tool including a lighter and a bottle opener with Hicks' teaching of a cigarette handling system. To the contrary, Walker discloses that the multi-purpose tool could "easily fit within the pocket of a waiter or other server" and that the device "will enable multiple tasks to be accomplished in a quick effective manner that is critical in the service industry" (Col. 4, lines 13-18). The tool described can include a blade, cork screw, pen, lighter, bottle opener and flashlight. By contrast, a container to hold a partially smoked cigarette seems hardly to fit within the purpose of the multi-use tool described in Walker. Walker's tool is intended for service staff to perform their various service tasks. Carrying around a partially smoked cigarette does not seem appropriate for such a tool. Further, there is no motivation to combine suggested in Hicks. Hicks merely describes a cigarette handling system that, in one embodiment, can include a wire to optionally hold a lighter. There is no suggestion in Hicks of including one or more tools as part of the device. Accordingly, the applicant respectfully submits there is no motivation to combine Hicks and Walker.

Second, to establish a case of *prima facie* obviousness, "there must be a reasonable expectation of success". There is no reasonable expectation of success when combining Hicks and Walker, as neither disclose "a container having an open end, a hollow interior having a

Applicant : Steven K. Coulthard
Serial No. : 10/656,446
Filed : September 5, 2003
Page : 9 of 10

Attorney's Docket No.: 16217-002001

substantially constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end forming the hollow interior, wherein the open end is permanently open and is configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette", as required by the claim. Further, neither disclose the clip required by the second limitation of claim 1. Thus, even in combination, there is no reasonable expectation of successfully producing an apparatus as recited in claim 1.

Third, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" [MPEP, §2143]. Neither Hicks nor Walker, alone or in combination, disclose the limitations of claim 1. Particularly, as mentioned above, neither disclose the container or the clip as required by claim 1. Thus, even in combination, not all limitations are taught.

Accordingly, the applicant respectfully submits that as a *prima facie* case of obviousness has not been established, claim 1 is allowable over Hicks in view of Walker. Claims 2-10 depend from claim 1 and are therefore allowable for at least the same reasons.

Claims 11-17

Claim 11 recites an apparatus for extinguishing and containing a cigarette. The apparatus includes the following features:

a container having:

an open end, a hollow interior having a substantially constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end, wherein the open end is permanently open and configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette;

a first and a second resilient arm, each arm extending from the container configured to grasp a cigarette lighter, the first arm bowed toward the second arm and the second arm bowed toward the first arm; and

a bottle opener connected to the exterior of the container.

Applicant : Steven K. Coulthard
Serial No. : 10/656,446
Filed : September 5, 2003
Page : 10 of 10

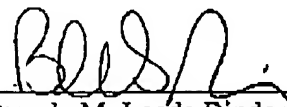
Attorney's Docker No.: 16217-002001

For at least the reasons stated above in reference to claim 1, claim 11 is allowable over Hicks in view of Walker. Hicks in combination with Walker fails to disclose "a container having an open end, a hollow interior having a substantially constant interior diameter, a closed end, and a continuous wall extending between the open end and the closed end, wherein the open end is permanently open and configured to receive a cigarette, the interior is configured to contain a cigarette and the container is configured to extinguish a cigarette", as required by the claim. Further, neither Hicks nor Walker disclose an apparatus includes a first and a second resilient arm extending from such a container configured to grasp a cigarette lighter. Further, although Walker discloses a bottle opener, there is no motivation to combine the teachings of a multi-use tool disclosed in Walker with the cigarette handling system disclosed in Hicks. Accordingly, a *prima facie* case of obviousness has not been established and claim 11 is in condition for allowance. Claims 12-17 depend from claim 11 and are therefore allowable for at least the same reasons.

Please deduct \$225.00 from deposit account 06-1050 for the Petition for Extension of Time fee for a 2 month extension. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Dec 9/05


Brenda M. Leeds Binder
Reg. No. 57,520

Fish & Richardson P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50289147.doc